

### **REMARKS**

In response to the Office Action mailed on December 4, 2003, claims 1-6, 9, 43-49, 56, 57 and 64 are amended, and claims 94-102 are added. Claims 7, 8, 10-42, 50-55, 58-63, 71-76 and 79-84 are withdrawn, as a result, claims 1-84 and 94-102 are now pending in this application.

#### **§101 Rejection of the Claims**

Claims 1-6, 9, 43-49, 56 and 57 were rejected under 35 U.S.C. § 101 as lacking utility on the grounds that a waveform does constitute patentable subject matter.

Claims 1-6, 9, 43-49, 56 and 57 were amended to clarify that the claims are directed toward a defibrillator providing a particular waveform. Applicant notes that such amendments were not made in response to a prior art rejection, and these amendments are believed to be non-narrowing. Applicant respectfully requests withdrawal of the rejection and reconsideration and allowance of claims 1-6, 9, 43-49, 56 and 57.

#### **§112 Rejection of the Claims**

Claims 1-6 and 9 were rejected under 35 U.S.C. § 112, second paragraph, for indefiniteness.

Base claim 1 was amended as suggested in the Office Action to better recite the subject matter, and not in response to any prior art rejection. Applicant respectfully requests withdrawal of the rejection and reconsideration and allowance of claims 1-6 and 9.

#### **§102 Rejection of the Claims**

1. Claims 1-6, 9, 43-49, 56, 57, 64-70, 77 and 78 were rejected under 35 U.S.C. § 102(e) for anticipation by Baker, Jr. et al. (U.S. Patent No. 5,974,339, "Baker"). Applicant respectfully traverses.

As an initial note, Applicant does not admit that Baker is prior art and reserves the right to swear behind Baker under 37 C.F.R. § 1.131 at a later date. Nevertheless, Applicant believes these claims are distinguishable from Baker for the reasons stated below.

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*Regarding claims 1-6 and 9:*

Applicant cannot find in the indicated portions of Baker, among other things, any disclosure of:

a positive voltage phase beginning at about zero volts and having an initial positive voltage magnitude greater than zero volts, the positive voltage phase having a first positively sloped portion extending from the initial positive voltage magnitude to a maximum positive voltage magnitude greater than the initial positive voltage magnitude,

as recited or incorporated in these claims. Instead, Baker discusses a waveform that begins at zero volts. (Contrast FIG. 5 of the present application with FIG. 13 of Baker.)

Therefore, Applicant respectfully requests reconsideration and allowance of claims 1-6 and 9.

*Regarding claims 43-49, 56-57, 64-70, 77 and 78:*

Applicant cannot find in the indicated portions Baker, among other things, any disclosure of a positive phase waveform shape independently selectable from a first set of waveform shapes and a negative phase waveform shape independently selectable from a second set of waveform shapes, as presently recited or incorporated in these claims.

Therefore, Applicant respectfully requests reconsideration and allowance of claims 43-49, 56-57, 64-70, 77 and 78.

2. Claims 1, 2, 5, 6, 9, 43-49, 56, 57, 64-70, 77 and 78 were rejected under 35 U.S.C. § 102(b) for anticipation by Weiss (U.S. Patent No. 5,184,616). Applicant respectfully traverses.

*Regarding claims 1, 2, 5, 6 and 9:*

Applicant cannot find in the indicated portions of Weiss, among other things, any disclosure of:

a positive voltage phase beginning at about zero volts and having an initial positive voltage magnitude greater than zero volts, the positive voltage phase having a first positively sloped portion extending from the initial positive voltage magnitude to a maximum positive voltage magnitude greater than the initial positive voltage magnitude,

as recited or incorporated in these claims. Instead, Weiss discloses waveforms that begin at zero volts and not waveforms that have an initial voltage greater than zero volts. (Contrast FIG. 5 of the present application with FIG. 8 of Weiss.)

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Therefore, Applicant respectfully requests reconsideration and allowance of claims 1, 2, 5, 6 and 9.

*Regarding claims 43-49, 56-57, 64-70, 77 and 78:*

Applicant cannot find in the indicated portions of Weiss, among other things, any disclosure of a positive phase waveform shape independently selectable from a first set of waveform shapes and a negative phase waveform shape independently selectable from a second set of waveform shapes, as presently recited or incorporated in these claims. Instead, Weiss apparently allows only certain combinations of first and second shapes. For example, FIG. 8 of Weiss shows that a combination of the triangular positive phase of waveform 124 with the negative sine-type wave of waveform 125 is not available. Thus, the positive and negative phases are not independently selectable in Weiss.

Applicant respectfully requests reconsideration and allowance of claims 43-49, 56-57, 64-70, 77 and 78.

3. Claims 1, 2, 5, 6, 9, 43-49, 56, 57, 64-70, 77 and 78 were rejected under 35 U.S.C. § 102(b) for anticipation by Brink (U.S. Patent No. 5,725,560). Applicant respectfully traverses.

*Regarding claims 1, 2, 5, 6 and 9:*

Applicant cannot find in the indicated portions Brink, among other things, any disclosure of:

a positive voltage phase beginning at about zero volts and having an initial positive voltage magnitude greater than zero volts, the positive voltage phase having a first positively sloped portion extending from the initial positive voltage magnitude to a maximum positive voltage magnitude greater than the initial positive voltage magnitude,

as recited or incorporated in these claims. Instead while Brink does refer to a waveform that has an initial voltage greater than zero volts, Brink's waveform does not extend from initial positive voltage to a voltage magnitude greater than the initial voltage (i.e. a positive slope). (Contrast FIG. 5 of the present application with FIG. 8 of Brink.)

Therefore, Applicant respectfully requests reconsideration and allowance of claims 1, 2, 5, 6 and 9.

*Regarding claims 43-49, 56-57, 64-70, 77 and 78:*

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Applicant cannot find in the indicated portions of Brink, among other things, any disclosure of a positive phase waveform shape independently selectable from a first set of waveform shapes and a negative phase waveform shape independently selectable from a second set of waveform shapes, as presently recited or incorporated in these claims. Instead, only certain combinations of first and second waveform shapes are apparently allowed in Brink. For example, FIG. 8 of Brink shows that a combination of the triangular positive phase of waveform 145 with the negative sine-type wave of waveform 125 is not available. Thus, Brink's positive and negative phases are not independently selectable.

Therefore, Applicant respectfully requests reconsideration and allowance of claims 43-49, 56-57, 64-70, 77 and 78.

#### New Claims

Claims 94 to 102 are new. Claims 94 to 101 reintroduce subject matter found in FIGS. 5 through 13 that was previously withdrawn. However, such claims are fully consistent with Applicant's election in response to the Restriction Requirement dated August 4, 2003, because these claims are drawn toward a defibrillator providing a particular waveform. New claims 94 to 101 correspond to withdrawn claims 51, 52, 54, and 58-62. Support in the specification for new claim 102 may be found on page 31 lines 1-5. Applicant requests entry of the new claims for examination.



Conclusion

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at 612-373-6951 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743

Respectfully submitted,

LEO RUBIN ET AL.

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Date January 16, 2004

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 16 day of January, 2004.

Paula Suehy

Name

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